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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SHINGLES, KRISTIE D

ART UNIT PAPER NUMBER

2141

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/954,832

Applicant(s)

PARRY ET AL.

Examiner

Kristie Shingles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

*Applicant has amended claims 1-7, 11-17 and 21-23. Claims 26-32 have been added.
Claims 1-32 are pending.*

Response to Arguments

1. Applicant's arguments, see Remarks filed 3/7/2005, with respect to the rejections of claims 1, 8, 11 and 18 under 35 USC 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of *Chong* (USPN 5,175,684) and *Adamske et al* (USPN 6,615,234).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims **1-5, 8, 11, 16-18, 21, 22, 24-27 and 29** are rejected under 35 U.S.C. 102(b) as being anticipated by *Chong* (USPN 5,175,684).

a. **Per claims 1 and 8** (differs by statutory subject matter), *Chong* teaches a method for facilitating generation of a hard copy, comprising:

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- selecting a document file written in a first language (col.3 lines 59-65);
- selecting a translator configured to translate the document file into a second language (col.3 line 65-col.4 line 11); and
- packaging the document file and the translator together in a job package that can be received by a hard copy generation device (col.3 line 65-col.4 line 29, col.4 lines 49-63 and col.6 lines 13-54).

b. **Per claims 11 and 18** (differs by statutory subject matter), *Chong* teaches a method for generating a hard copy, comprising:

- receiving a job package comprising a document file representing a document, the document file written in a first language, and a translator configured to translate the document file into a second language (col.3 line 59-col.4 line 11);
- opening the job package (col.5 line 65-col.6 line 54 and col.7 line 1-col.8 line 65);
- using the translator to translate the document file into the second language (col.3 line 65-col.4 line 11 and col.8 lines 6-54); and
- generating a hard copy of the document (col.9 lines 21-44).

c. **Per claims 21 and 24** (differs by statutory subject matter), *Chong* teaches a method for generating a hard copy, comprising:

- receiving an address that identifies the location of a job package that comprises a document file representative of a document, the document file written in a first language and a translator configured to translate the document file into a second language (col.3 line 59-col.4 line 8 and col.5 line 65-col.6 line 54);
- retrieving the job package (col.3 line 59-col.4 line 11);
- opening the package (col.5 line 65-col.6 line 54 and col.7 line 1-col.8 line 65);
- using the translator to translate the document file into the second language (col.3 line 65-col.4 line 63 and col.8 lines 6-54); and
- generating a hard copy of the document (col.9 lines 21-44).

d. **Per claim 2**, *Chong* teaches the method of claim 1, wherein selecting a document file comprises selecting a document file identified by a user (col.7 line 3-18).

e. **Per claim 3, Chong** teaches the method of claim 1, wherein the step of selecting a translator comprises selecting a translator identified by a user (col.4 lines 9-17 and col.6 lines 21-54).

f. **Per claim 4, Chong** teaches the method of claim 1, further comprising the step of transmitting the job package to the hard copy generation device (col.9 lines 28-44).

g. **Per claim 5, Chong** teaches the method of claim 1, further comprising the step of transmitting the job package to a recipient computing device (col.4 lines 9-63 and col.5 lines 11-54).

h. **Claim 27** is substantially similar to claim 5 and is therefore rejected under the same basis.

i. **Claim 29** is substantially similar to claim 4 and is therefore rejected under the same basis.

j. **Per claim 16, Chong** teaches the method of claim 11, further comprising the step of registering with a remote computing device prior to generating the hard copy (col.9 lines 22-44).

k. **Per claim 17, Chong** teaches the method of claim 16, wherein the step of generating a hard copy is enabled by the remote computing device (col.4 lines 9-63, col.5 lines 11-54 and col.9 lines 22-44).

l. **Per claim 22, Chong** teaches the method of claim 21, wherein the step of retrieving the job package comprises retrieving the package from a remote location via a network (col.4 line 49-col.6 line 53, col.8 lines 19-43 and col.9 lines 22-44).

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m. **Claim 25** is substantially similar to claim 22 and is therefore rejected under the same basis.

n. **Per claim 26**, *Chong* teaches the method of claim 1, further comprising transmitting the job package over a network as an email attachment (col.9 lines 28-34).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 6, 7, 9, 10, 12-15, 19, 20, 23, 28 and 30-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Chong* (USPN 5,175,684) in view of *Adamske et al* (USPN 6,615,234).

a. **Per claim 6**, *Chong* teaches the method of claim 1 as applied above, yet fails to explicitly teach method of claim 1, further comprising the step of encrypting the job package. However, *Adamske et al* disclose encryption of the translated document prior to delivery (col.3 line 64-col.4 line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Chong* and *Adamske et al* for the purpose of provisioning security and the integrity of the document through the network by implementing encryption.

b. **Claims 9, 12 and 28** are substantially similar to claim 6 and are therefore rejected under the same basis.

c. **Per claim 32**, *Chong* teaches the method of claim 21 as applied above, yet fails to explicitly teach the method of claim 21, wherein receiving an address comprises receiving a universal resource locator (URL) that identifies the location of the job package. However, *Adamske et al* disclose use of a URL for locating the document. *Adamske et al* teach encryption, and it is therefore intrinsic and obvious (in order to achieve effective communication) to provision a method of decryption along with encryption, in order for the document/data to be comprehensible to the appropriate recipient. Furthermore, *Adamske et al* restrict access to the encrypted documents by implementing security features with electronic signatures, pass phrases and user IDs that prohibit access of the document until authentication of the signatures, wherein the document will be decrypted for receipt and viewing once the authentication has been satisfied (col.6 lines 1-23 and col.8 line 24-col.9 line 32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Chong* and *Adamske et al* for the purpose of provisioning a decryption method along with an encryption method for making content accessible to the recipient and to furthermore utilize URLs as locators for documents, since URL provide access to electronic documents, data and media on the web/Internet.

d. **Claims 7, 10, 13-15, 19, 20, 23 and 30** contain limitations that are substantially similar to claim 32 and are therefore rejected under the same basis.

e. **Per claim 31**, *Chong* teaches the method of claim 16 as applied above, yet fails to explicitly teach the method of claim 16, wherein registering comprises registering with a remote computing device for the purpose of determining whether a total number of hard copies have already been generated and, if so, prohibiting generation of a further hard copy. However,

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Adamske et al disclose use of a print spooler which keeps track of the number of hard copies have been generated and indicates when the hard copy generation has completed (col.7 lines 16-43 and col.7 line 57-col.8 line 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Chong* and *Adamske et al* for the purpose of provisioning monitoring/tracking of the number of hard copies generated/printed in order to properly process the document/data in its entirety; because it allows for management of hard copy generation.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: *Arellano-Payne et al* (US 20040015891), *Wong et al* (US 20040015890), *Edmunds* (USPN 6,006,281), *Wadewitz* (USPN 6,249,786) and *Gase* (USPN 6,856,430).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

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